

In response to the amendment Applicants filed on August 29, 2002, the Examiner has indicated that claims 14, 16 and 42-45 contain allowable subject matter, rejected Claims 1-4, 6, 7, and 49 were under §103(a) as being unpatentable over Kuhar (U.S. Patent No. 5,482,100) in view of Carouso (U.S. Patent No. 1,863,620), rejected claims 49-51 under §103(a) as being unpatentable over Kuhar in view of Griswold (U.S. Patent No. 350, 429), rejected claims 5, 12, 13, 15, 17 and 18 under 35 U.S.C. §103(a) as being unpatentable over Kuhar in view of Carouso and further in view of Griswold, rejected claim 8 under §103(a) as being unpatentable over Kuhar in view of Carouso and further in view of Conklin, Jr. (U.S. Patent No. 4,055,038), and rejected claims 38-41 and 53 under §103(a) as being unpatentable over Kuhar in view of Judkins et al. (U.S. Patent No. 5,176,192). The applicants respectfully traverse these rejections.

#### **Rejections of Claims 1-4, 6, 7 and 49 over Kuhar in view of Carouso**

Regarding claims 1-4, 6 and 7, assuming, *arguendo*, that the pulleys 25 disclosed in Carouso are tensioning mechanisms, the axes of the pulleys 25 are perpendicular to the axis of the reels 19, 20 as opposed to being parallel as recited in independent claim 1. Even the axes of the pulleys 25 themselves are not parallel. Carouso does not suggest rearranging the pulleys 25 and reels 19, 20 such that all three axes are parallel. In fact, if the pulleys 25 were configured with their axes vertical and parallel to the axes of the reels 19, 20, it appears that the cords 17 would slip off the pulleys 25 as disclosed in Carouso. Therefore, for at least this reason, the combination of Kuhar and Carouso does not render claims 1-4, 6 and 7 obvious.

Regarding claim 7, Applicants are unclear as to the "broad definition of the term" "compliant" to which the Examiner is referring. Nevertheless, Carouso provides no teaching or discussion whatsoever of the characteristics of the outer surface of the pulleys 25, let alone of the material from which the pulleys 25 are manufactured. Moreover, the character of the outer surface of the pulleys 25 as compliant is not an inherent characteristic of the pulleys 25. In order to find that a prior art patent "discloses" a feature, that feature must be either expressly disclosed in the patent or inherently disclosed in the patent. The standard for inherency is strict. Section 2112 of the M.P.E.P. sets forth the standard for inherency as follows:

The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the

inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) (reversed rejection because inherency was based on what would result due to optimization of conditions, not what was necessarily present in the prior art); *In re Oelrich*, 666 F.2d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981). >“To establish inherency, the extrinsic evidence ‘must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.’” (underlining original).

The compliancy of the outer surface of the pulleys 25 is not necessarily present and, therefore, not inherent. Consequently, the combination of Kuhar and Carouso does not render claim 7 obvious for this additional reason.

Regarding claim 49, assuming, *arguendo*, that the pulleys 25 taught by Carouso are balancing adjustment devices as recited in claim 49, a fact which Applicants are by no means conceding, Carouso contains no disclosure whatsoever that the pulleys 25 are accessible from the area external to the drum 12, let alone that the pulleys 25 may be actuated or altered to adjust their operation. As a result, the combination of Kuhar and Carouso does not render claim 49 obvious.

In addition to the reasons stated above, Applicants respectfully reassert that there is no suggestion or motivation for combining the Kuhar and Carouso references in the manner proposed by the Examiner. The prior art must make a suggestion of or provide an incentive for the claimed combination of elements in order to establish a *prima facie* case of obviousness. *In re Oetiker*, 24 U.S.P.Q.2d 1443, 1446 (Fed. Cir. 1992); *Ex parte Clapp*, 227 U.S.P.Q. 972, 973 (Bd. Pat. App. 1985). Merely stating integration of the claimed elements is obvious is not the same as “show[ing] a motivation to combine the references.” *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1457 (Fed. Cir. 1998). As explained by the Federal Circuit:

As this court has stated, “virtually all [inventions] are combinations of old elements.” Therefore, an examiner may often find every element of a claimed invention in the prior art. If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of

the claimed invention. Such an approach would be “an illogical and inappropriate process by which to determine patentability.” To prevent the use of hindsight based on the invention to defeat patentability of the invention, this court requires the examiner to show a motivation to combine the references that create the case of obviousness.

Id. at 1457 (citations omitted and emphasis added).

Simply arguing that the cited prior art references relate to the same field of endeavor is not sufficient to meet the suggestion requirement. In the *Rouffet* decision, “the parties agree[d] that the five references asserted by the examiner were in the same field of endeavor as the invention,” but the rejections were still held to be improper for failing to identify a proper suggestion for combining the cited art. *Id.* at 1456. In order to establish a *prima facie* case of obviousness, there must be actual evidence of a suggestion to modify a prior art reference or to combine two prior art references, and the suggestion to combine or modify the prior art must be clear and particular. *In re Dembiczak*, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999). In order to establish a *prima facie* case of unpatentability, particular factual findings demonstrating the suggestion to modify the prior art must be made. *See, e.g., Ecolochem Inc. v. Southern California Edison*, 56 U.S.P.Q.2d 1065 (Fed. Cir. 2000) and *Dembiczak*, 50 U.S.P.Q.2d at 1617-1618, where the Court of Appeals for the Federal Circuit stated:

In addition to demonstrating the propriety of an obviousness analysis, particular factual findings regarding the suggestion, teaching, or motivation to combine serve a number of important purposes, including: (1) clear explication of the position adopted by the Examiner and the Board; (2) identification of the factual disputes, if any, between the applicant and the Board; and (3) facilitation of review on appeal.

The law is quite clear that an obviousness rejection must be based on facts, not conjecture.

The Supreme Court... foreclosed the use of substitutes for facts in determining obviousness under section 103. The legal conclusion of obviousness must be supported by facts. Where the legal conclusion is not supported by facts it cannot stand.

*In re Warner*, 379 F.2d 1011, 1017 (C.C.P.A. 1967). This longstanding principle has been followed to date. For example, in the unpublished Board decision, *Ex parte Megens*, App. No. 1999-0277 (B.P.A.I. Oct. 29, 1999), the Board stated:

Rejections based on 35 U.S.C. § 103 must rest on a factual basis. *In re Warner*, 379 F.2d 1011, 1017, 154 USPQ 173, 177-

78 (CCPA 1967). In making such a rejection, an examiner has the initial duty of supplying the requisite factual basis and may not, because of doubts that the invention is patentable, resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in the factual basis. *Id.*

(*Megens* at Page 4).

Furthermore, the mere fact that references can be modified is not sufficient to establish *prima facie* case of obviousness. See Section 2143.01 of the M.P.E.P., which states: "The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990)" (emphasis original). The suggestion to combine references must be from the prior art, not the Applicants' disclosure. See Section 2143 of the M.P.E.P., which states: "The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in Applicants' disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991)."

Applicants respectfully resubmit that the Kuhar and Carouso references are neither analogous art, as admitted by the Examiner, nor in the same field of endeavor. Kuhar relates to cordless blinds wherein a constant variable spring motor is adapted to balance the blinds by providing a variable force that is "at its highest level when the blind or shade is fully raised, i.e., when the cords are supporting the full weight of the window covering [and] at its lowest point when the window covering is fully lowered and, in the case of blinds, the slats are being individually supported by ladders, rather than by the cords, leaving only the bottom bar to be supported by the cord." Kuhar, Abstract and col. 2, lines 40-50. Carouso, conversely, does not relate to using a spring motor to balance a varying weight. Instead, Carouso provides springs 30 that at all times exert forces sufficient to overcome the weight of the cords 17 and supported heaters 34, and to rewind the cords 17 onto reels 19, 20. Carouso, in fact, teaches away from balancing by providing dogs 31 in discs 28 engaging detents 32 of the pulleys 25 to prevent the pulleys 25 from rotating by the urging of the springs 30 actuating the reel and tending to rewind the cord cords 17 on the reels 19, 20. Carouso, page 2, lines 5-24. Therefore, Kuhar (balancing a varying amount of weight) and Carouso (providing a locking mechanism to prevent rewinding by a spring always supplying sufficient force to overcome a suspended weight) do not relate to the same field of endeavor.

Even if we assume that Kuhar and Carouso relate to the same field of endeavor, Applicants respectfully submit that the Examiner has provided no factual basis for a suggestion or motivation to combine the references. Stating that one of ordinary skill in the art experiencing problems with counterbalanced blinds having spring motors that are not properly tensioned would look to Carouso is conclusory and impermissibly uses the Applicants' own disclosure to create the motivation to combine the references, which constitutes an improper hindsight analysis. Further, the Examiner's statement that the pulleys 25 of Carouso are "superior" to structures in Kuhar is unsupported by any facts whatsoever. Even if true, which, depending the factors relevant to determining which of two alternatives is "superior" may lead to different conclusions, the Examiner has cited no support for the proposition that substituting a superior alternative for a disclosed alternative constitutes sufficient motivation or suggestion for the combination. As previously stated, the mere fact that references can be modified is not sufficient to establish a *prima facie* case of obviousness. For these additional reasons, Applicants respectfully submit that the Examiner has not established a *prima facie* case of obviousness of claims 1-4, 6, 7 and 49 and, therefore, Applicants respectfully request an indication of allowance of these claims.

#### **Rejection of Claims 49-51 over Kuhar in view of Griswold**

Claims 49-51 recite, *inter alia*, "a balancing adjustment device configured to allow the consumer to adjust the operation of the spring motor, the balancing adjustment device being adapted to be actuated by the consumer from an area external to the one of the headrail and the bottom rail." Initially, similar to Carouso, Griswold does not relate to the same field of endeavor as Kuhar. As previously discussed, Kuhar is directed to balancing a varying amount of weight, i.e., the force of the spring varies in proportion to the weight of the bottom rail and the accumulated slats. Conversely, Griswold has a suspended article with a fixed weight that remains constant as the force of the spring C increases and decreases as the suspended article is lowered and raised. In order to hold the suspended article in position when the force of the spring C is insufficient to support the suspended article, Griswold further provides the brake J to engage the drum A to resist rotation of the drum in the direction to unwind the cords B when the weight of the suspended article is applied. Because the brake J prevents unwinding of the cords B, and the weight of the suspended article is not

variable, it follows that Griswold does not endeavor to use a spring motor to balance a varying weight as addressed in Kuhar.

Even assuming, *arguendo*, that Kuhar and Griswold relate to the same field of endeavor, Applicants respectfully submit that the Examiner has provided no factual basis for a suggestion or motivation to combine the references. At most Kuhar discloses applying tension or friction to a lift cord. Kuhar does not, however, disclose or suggest coupling a balance adjustment device to the spring motor, and Griswold does not disclose or suggest that the brake J and drum A arrangement may be implemented where a spring motor is balancing a varying amount of weight. Moreover, similar to the rejections involving Carouso, stating that one of ordinary skill in the art experiencing problems counterbalancing different sized blinds with a spring motors would look to Griswold is conclusory and impermissibly uses the Applicants' disclosure to create the motivation to combine the references, which constitutes an improper hindsight analysis. Once again, the mere fact that references can be modified is not sufficient to establish a *prima facie* case of obviousness. For these additional reasons, Applicants respectfully submit that the Examiner has not established a *prima facie* case of obviousness of claims 49-51 and, therefore, Applicants respectfully request an indication of allowance of these claims.

**Rejection of Claims 5, 12, 13, 15, 17 and 18 over Kuhar in view of Carouso and further in view of Griswold**

Carouso and Griswold together do not provide the suggestion or motivation missing from each other as discussed above to combine the references with Kuhar, let alone to combine all three references. Moreover, regarding claim 12, as discussed with respect to claims 49-51, Kuhar does not disclose or suggest coupling a biasing element or a bias adjustment mechanism to the spring motor, Griswold does not disclose or suggest that the brake J and drum A arrangement may be implemented where a spring motor is balancing a varying amount of weight, and Carouso does not provide the missing disclosure or suggestion. Therefore, for at least these reasons discussed above, the combination of Kuhar in view of Carouso and further in view of Griswold does not render claims 5, 12, 13, 15, 17 and 18 obvious.

**Rejection of Claim 8 over Kuhar in view of Carouso and further in view of Conklin, Jr.**

Conklin, Jr. does not provide the necessary suggestion or motivation for the combination Kuhar and Carouso missing from those references as discussed above. Consequently, the combination of Kuhar, Carouso and Conklin, Jr. does not render claim 8 obvious.

**Rejection of Claims 38-41 over Kuhar in view of Judkins et al.**

Claim 38 recites a "means for applying a varying amount of weight to the bottom rail to counterbalance the force of the spring motor, the amount of weight applied to the bottom rail being adapted to maintain the bottom rail in a given position with respect to the headrail." As previously discussed, Kuhar teaches at most applying tension or friction to a lift cord. Applicants reassert the arguments presented in the amendment filed on August 28, 2002. Kuhar contains no suggestion of varying the weight of the bottom rail to counterbalance the force of the spring motor, and Judkins, et al. only discloses or suggests the use of a weight W in a bottom rail to shift the weight of the bottom rail rearward and ensure the bottom rail hangs with a desired orientation. Judkins et al. contains no disclosure or suggestion of using the weight W to counterbalance the force of a spring motor as recited in claim 38. Applicants' respectfully submit that the conclusory statements presented in the Office action regarding the desirability of providing weight to the bottom rail of a blind, that a weight in the bottom rail of the Kuhar device would result in better hanging characteristics, and that it is obvious that the weight must be chosen to maintain the balanced feature of Kuhar do not provide a sufficient factual basis for supporting the combination of Kuhar and Judkins et al. proposed by the Examiner. In fact, stating that the weight must be chosen so as to "maintain" the balanced feature of Kuhar implies that weight is being added to an already-balanced blind and, therefore, the added weight somehow does not counterbalance the spring motor as recited in the claims. Be that as it may, yet again, the mere fact that references can be modified is not sufficient to establish a *prima facie* case of obviousness. For these reasons, Applicants respectfully submit that the Examiner has not established a *prima facie* case of obviousness of claims 38-41 and, therefore, Applicants respectfully request an indication of allowance of these claims.

For at least the foregoing reasons, reconsideration and withdrawal of the rejection of claims 1-13, 15, 17, 18, 38-41 and 49-51, and allowance of the currently pending claims are respectfully requested. The applicant files concurrently herewith a notice of appeal to take the matter to the Board of Patent Appeals and Interferences should the examiner not be convinced upon considering this response. Should the Examiner wish to discuss the foregoing or any matter of form in an effort to advance this application towards allowance, he is urged to telephone the undersigned at the indicated number.

Respectfully submitted,

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